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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,232	08/08/2001	Ruth E. Rosenholtz	110338	9881
27074	7590	09/23/2004	EXAMINER	
OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			BLACKWELL, JAMES H	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/682,232

Applicant(s)

ROSENHOLTZ ET AL.

Examiner

James H Blackwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-30 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 31 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/30/01, 4/19/02  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Note*

Included with the Graham reference is a copy of the web site that is depicted in the Figures. The intention is to provide a clear copy of the figure contents due to the poor reproduction of the copy of the Graham reference provided.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Graham ("The Reader's Helper: A Personalized Document Reading Environment", May 15-20, 1999, Pittsburgh, PA).

In regard to independent Claim 1 (and similarly independent Claims 7, 14, and 20), Graham teaches a Thumbar view, which is a reduced version of the original document (see Fig. 1, item 1.1; p. 3, left col., top of col.; compare with Claim 1 (and similarly Claims 7, 14, and 20), "**... generating a reduced-size representation of an original document**"). Graham also teaches an original web page containing hyperlinked portions, and thereby selectable (see Fig. 1). The copyright hyperlink is an example of a link to a document other than the original document. Compare with Claim 1 (and similarly Claims 7, 14, and 20), "**... the original document having at least one**

***first selectable element, each at least one first selectable element having, as an associated destination one of (b) a document other than the original document”).***

Graham also teaches the notion of document annotation, by use of an annotation agent. The agent highlights relevant portions, such as keywords or key phrases in the original web page and in the reduced Thumbar version (see Fig. 2, p. 4, left col.; compare with Claim 1 (and similarly Claims 7, 14, and 20), “... ***generating at least one second selectable element***”). Note that the element is selectable by virtue of the user moving the Thumbar “lens” over the portion of the reduced document containing the annotation. Also, it is possible, by moving the Thumbar “lens” to move to a highlighted word or phrase corresponding to the original page which also contains hyperlinks (given that the original page, with annotations, could contain both). Compare with Claim 1 (and similarly Claims 7, 14, and 20), “... ***each at least one second selectable element corresponding to an associated destination of one of the at least one first selectable element***”). Graham also teaches that the annotated elements are reflected in the Thumbar view of the document and that the element is selectable by virtue of the user moving the Thumbar “lens” over the portion of the reduced document containing the annotation (Fig. 2; compare with Claim 1 (and similarly Claims 7, 14, and 20), “... ***associating the at least one second selectable element with the reduced-size representation in a display of the reduced-size representation, whereby the one of (a) the one of the document areas is directly accessible by selection of the one of the at least one second selectable element***”).

In regard to dependent Claim 2 (and similarly dependent Claim 15), Graham teaches that the Thumbar, a reduced version of the original document, contains all its elements in a reduced size (thereby modified in appearance) relative to the elements in the original document (see Fig. 1, item 1.1; p. 3, left top col.; compare with Claim 2 (and similarly Claim 15), “... ***the reduced-size representation has at least one element with a modified appearance relative to an appearance of a corresponding element in the original document***”).

In regard to dependent Claim 3 (and similarly dependent Claim 16), Graham teaches that the highlighted words or phrases are selectable by virtue of the user moving the lens the sections of the Thumbar view containing the annotations. Compare with Claim 3 (and similarly Claim 16), “... ***the at least one element with a modified appearance is the at least one second selectable element***”).

In regard to dependent Claim 4 (and similarly dependent Claim 17), Graham teaches that the annotations present in the original document are also reflected in the Thumbar version of the document and are visibly different by virtue of three different highlighting schemes (p. 4; left and right-hand cols.; compare with Claim 4 (and similarly Claim 17), “... ***the at least one second selectable element is a visibly discrete element***”).

In regard to dependent Claim 5 (and similarly dependent Claim 18), Graham teaches web pages containing images that are reduced by the Thumbar view (See Fig. 2; compare with Claim 5 (and similarly Claim 18), “... ***the reduced-size representation is a reduced image***”).

In regard to dependent Claim 6 (and similarly dependent Claim 19), Graham teaches a document annotation agent that highlights elements of the original document (keywords, phrases, etc...) that are relevant to a users needs (Fig. 2, p. 4). These highlighted words or phrases are selectable by virtue of the user moving the lens the sections of the Thumbar view containing the annotations. Compare with Claim 6 (and similarly Claim 19), **"... generating the at least one second selectable element comprises generating a plurality of second selectable elements"**.

In regard to independent Claim 8 (and similarly independent Claims 13, 21, and 26), Graham teaches a Thumbar view, which is a reduced version of the original document (see Fig. 1, item 1.1; p. 3, left col., top of col.; compare with Claim 8 (and similarly Claims 13, 21, and 26), **"... generating a reduced-size representation of an original document"**). Graham also teaches an original document containing a number of document portions (images, abstract, keywords, etc. None of these seem to be associated with links, compared to other portions of the web page that contain obvious hyperlinks (see Fig. 1, item 1.3, and based on Thumbar views, 1.1 & 1.2; compare with Claim 8 (and similarly Claims 13, 21, and 26), **"... the original document having a plurality of document portions, smaller than the original document and not uniquely associated with any first selectable element provided in the original document"**). Graham also teaches that the Thumbar, a reduced version of the original document, contains all its elements in a reduced size (thereby modified in appearance) relative to the elements in the original document (see Fig. 1, item 1.1; p. 3, left top col.; compare with Claim 8 (and similarly Claims 13, 21, and 26), **"... the reduced-size**

**representation having at least one element with a modified appearance relative to an appearance of a corresponding element in the original document”).** Graham also teaches the notion of document annotation, by use of an annotation agent. The agent highlights relevant portions, such as keywords or key phrases in the original web page and in the reduced Thumbar version (see Fig. 2, p. 4, left col.; compare with Claim 8 (and similarly Claims 13, 21, and 26), “... **generating at least one second selectable element**”). Note that the element is selectable by virtue of the user moving the Thumbar “lens” over the portion of the reduced document containing the annotation. Graham also teaches that these elements can be a part of the original document portion (see Fig. 2, highlighting in sec. Labeled “Prior Experience”; compare with Claim 8 (and similarly Claims 13, 21, and 26), “... **each second selectable element corresponding to one of the plurality of document portions**”). Graham also teaches that one can move the lens (1.2) over the Thumbar representation of the original document to a portion of the document that is highlighted by annotation, thereby selecting the highlighted elements for close-up view in the main viewer (Fig. 2, p. 4, left col.; compare with Claim 8 (and similarly Claims 13, 21, and 26), “... **each at least one second selectable elements having, as an associated destination, one of the plurality of document portions**”). Graham also teaches that the annotated elements are reflected in the Thumbar view of the document and that the element is selectable by virtue of the user moving the Thumbar “lens” over the portion of the reduced document containing the annotation (Fig. 2; compare with Claim 8 (and similarly Claims 13, 21, and 26), “... **associating the at least one second selectable element with the reduced-size**

***representation in a display of the reduced-size representation, whereby the one of the document portions is directly accessible by selection of the one of the at least one second selectable element”).***

In regard to dependent Claim 9, Graham teaches that the annotations present in the original document are also reflected in the Thumbar version of the document (p. 4; compare with Claim 9 (and similarly Claim 22), “... ***the at least one element with a modified appearance is the at least one second selectable element”***”).

In regard to dependent Claim 10, Graham teaches that among the highlighting choices for highlighting the annotated phrases is to use underlining (p. 4, right-hand col., 2<sup>nd</sup> paragraph). This would make the highlighted phrase indistinguishable from a hyperlink that would have already existed in the original and reduced Thumbar versions of the page. Compare with Claim 10 (and similarly Claim 23), “... ***the at least one second selectable element is not a visibly discrete element”***”).

In regard to dependent Claim 11, Graham teaches web pages containing images that are reduced in the Thumbar view (See Fig. 2; compare with Claim 11 (and similarly Claim 24), “... ***the reduced-size representation is a reduced image”***”).

In regard to dependent Claim 12, Graham teaches a document annotation agent that highlights elements of the original document (keywords, phrases, etc...) that are relevant to a users needs (Fig. 2, p. 4). These highlighted words or phrases are selectable by virtue of the user moving the lens the sections of the Thumbar view containing the annotations. Compare with Claim 12 (and similarly Claim 25), “...



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***generating the at least one second selectable element comprises generating a plurality of second selectable elements”).***

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham.

In regard to dependent Claim 27 (and similarly dependent Claim 28), Graham teaches that the RH system was implemented in Java on a PC running Windows NT 4.0. It also runs under the Solaris and Linux operating systems as well. It is HTML 3.2 compatible and can be used for regular browsing of the WWW (p. 7 of 9, right-hand col.; compare with Claim 27 (and similarly Claim 28), ***"An information storage medium on which is recorded a program for implementing the steps of Claim 1"***). Though not specifically taught, it would have been obvious to one of ordinary skill in the art at the time of invention to assume that having been implemented in a programming language on a computer under several operating systems, that one would wish to store the RH system on a medium such as a hard disk, or CD-ROM for future use and potential distribution.

In regard to dependent Claim 29 (and similarly dependent Claim 30), Graham teaches that the RH system was implemented in Java on a PC running Windows NT

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4.0. It also runs under the Solaris and Linux operating systems as well. It is HTML 3.2 compatible and can be used for regular browsing of the WWW (p. 7 of 9, right-hand col.; compare with Claim 29 (and similarly Claim 30), ***“An information storage medium on which is recorded a program for implementing the steps of Claim 8”***). Though not specifically taught, it would have been obvious to one of ordinary skill in the art at the time of invention to assume that having been implemented in a programming language on a computer under several operating systems, that one would wish to store the RH system on a medium such as a hard disk, or CD-ROM for future use and potential distribution.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell  
09/16/04

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER